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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,324	09/12/2000	Kie Y. Ahn	M4065.0127/P127-A	2581

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DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
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WASHINGTON, DC 20037-1526

EXAMINER

TOLEDO, FERNANDO L

ART UNIT	PAPER NUMBER
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2823

DATE MAILED: 05/08/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/660,324

Applicant(s)

AHN ET AL.

Examiner

Fernando Toledo

Art Unit

2823

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 23 April 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application: A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see ATTACHED ADVISORY ACTION.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 88,90-95 and 97-123.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. ☐ Other: _____

Wael Tabany
SUPERVISORY PRIMARY EXAMINER
TECHNOLOGY CENTER

ADVISORY ACTION

Response to Arguments

Applicant's arguments filed 23 April 2002 have been fully considered but they are not persuasive for the foregoing reasons.

Applicant contests that claim 122 is not indefinite and that the Examiner is misquoting the limitation of claim 122.

However, Examiner respectfully submits that claim 122 is vague and indefinite since forming just a trench in the insulator layer won't form an active circuit nor is it to form a silicon layer on top of the insulator layer. In the SOI example that the Applicant quotes on page 2, second paragraph of the Response filed on April 23, 2002, the silicon layer is placed *on* the insulator layer and then the silicon layer is the one processed to carry the active devices. The insulator layer does not contribute to the active device. Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In *re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See **also In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear,

correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

In re claim 88, Applicant contests that:

“In the rejection of claim 96, the Examiner asserts that Stone’s conductive layer 21 suggests the claimed metallization layer. This assertion is respectfully traversed. Stone’s conductive layer 21 is not anywhere described as having metallization patterns located thereupon, nor does Stone describe the use of metallization for connecting a passive device formed within an insulating layer within a chip.”

Examiner respectfully submits that Stone does teach all the limitations of claim 88, including but not limited to the assertions made by Applicant. In column 7, lines 1 – 20 Stone discloses, “the passive electronic component may directly abut and be joined by another plane of an electrically conductive material 21.” Further, Stone discloses that “[t]he electrically conductive plane 21 may be formed from any of the materials used to form electrically conductive plane 9 or any suitable material.” In column 6, lines 1 – 10; Stone discloses, “a voltage plane 9 directly abuts at least a portion of the electrically insulating plane 7. The voltage plane may be formed from any known electrical conducting materials. For example, copper or copper/INVAR/copper (CIC), among other materials...” Furthermore, figure 1 of the Stone reference teaches that the electrically conducting plane 21 has been patterned as can be seen by protrusion 23. Therefore, claim 88 stands rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fernando Toledo whose telephone number is (703) 305-0567. The examiner can normally be reached on Monday – Friday, 8am – 4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (703) 308-4918. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

	Fernando Toledo Patent Examiner Art Unit 2823
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April 30, 2002